

Application No. 09/931,896
Amendments Dated June 9, 2006
Reply to Office Action of March 10, 2006

REMARKS/ARGUMENTS

Claims

Claims 1-24 are pending in the application.

Claims 1-24 remain in the application.

Claims 1-24 are as previously presented.

Claims 25 and 26 are new.

Claim Rejections – 35 U.S.C. § 103

Claims 1 and 12-24

Claims 1 and 12-24 have been rejected under 35 U.S.C. §103(a) as being obvious in view of the U.S. Patent No. 6,199,045, granted to Michael L. Giniger and Warren Scott Hilton (hereinafter "Giniger") and the U.S. Patent Application Publication No. 2002/0183072, filed by Galia Steinbach, Yechiam Halevy and Yuval Rabin (hereinafter "Steinbach").

Section § 103 of 35 U.S.C. reads as follows:

35 U.S.C. 103 Conditions for patentability; nonobvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. (emphasis added)

One of the key concept of § 103(a) is "prior art". Thus, an invention shall be found obvious and hence, unpatentable, if two or more prior art references can be combined and/or modified,

Application No. 09/931,896
Amendments Dated June 9, 2006
Reply to Office Action of March 10, 2006

without any inventive step, such as to obtain the invention of the Applicant. Moreover, it must have been so at the time the invention was made.

Therefore, according to § 103(a), in order to qualify as prior art, a reference must have been publicly available at least before the invention was made. If the "prior" art reference becomes publicly available after the invention is made, it is art but not prior art. Otherwise, it would be retroactive obviousness, which is absurd since based on hindsight.

Hence, in order to render an invention obvious, a reference must have been publicly available at least before the earliest filing date of the Applicant's patent application.

In the present case, the patent application of the Applicant was filed in the U.S.A. on August 20, 2001. However, the Applicant claimed the priority of a corresponding Canadian patent application filed on August 18, 2000. Therefore, pursuant to § 119, which reads as follows:

35 U.S.C. 119 Benefit of earlier filing date; right of priority.

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing. (emphasis added)

Application No. 09/931,896
Amendments Dated June 9, 2006
Reply to Office Action of March 10, 2006

It is thus as if the Applicant's patent application was filed in the U.S.A. on August 18, 2000. In any case, with respect to § 103(a), August 18, 2000, is the latest date on which the invention could have been made. Consequently, for a reference to be prior art according to § 103(a), it must have been publicly available at least before August 18, 2000.

The Applicant wishes to point that the patent application of Steinbach was published on December 5, 2002. The patent application of Steinbach claims the priority of a provisional application filed on April 17, 2001. As shown above, the Applicant's patent application has an equivalent filing date of August 18, 2000.

From this comes two consequences. First, the patent application of the Applicant was filed before the filing of the provisional patent application of Steinbach. Therefore, the published patent application of Steinbach cannot be prior art under § 103(a) since it was filed after the patent application of the Applicant. Second, the patent application of Steinbach was published on December 5, 2002, that is, after the Canadian and even after the American filing date of the Applicant, thus after the invention was made. Therefore, Steinbach cannot be cited as prior art. In fact, it is quite the opposite. The published patent application of the Applicant, at least the Canadian one, could possibly be prior art to Steinbach.

Consequently, the patent application of Steinbach is not prior art and cannot be cited under § 103(a) as prior art since it was not publicly available at least before the earliest filing date of the Applicant's application.

In view of the foregoing, the Applicant respectfully believes that independent claims 1, 12 and 17 are patentable since they are not anticipated by Giniger and since Steinbach is not prior art. As for dependent claims 13-16 and 18-24, since they are depending upon patentable claims, they should also be deemed patentable.

Application No. 09/931,896
Amendments Dated June 9, 2006
Reply to Office Action of March 10, 2006

Claims 2, 4, 6 and 9

Claims 2, 4, 6 and 9 have been rejected under 35 USC §103(a) as being obvious in view of Giniger and Steinbach and in further view of the U.S. Patent Application Publication No. 2002/0089421, filed by Jonathan Farrington, Leonard H. Poll and Armando S. Valdes (hereinafter "Farrington").

In an argumentation similar to the one above, there is a citability issue with respect to the Farrington reference. As a matter of fact, the Farrington reference was published on July 11, 2002. However, the patent application of the Applicant was filed in the U.S.A. on August 20, 2001, but with a Canadian priority date of August 18, 2000. The Farrington reference was thus publicly available only after the American and Canadian filing dates of the application of the Applicant, thus after the invention was made. Therefore, *per se*, the Farrington reference cannot be prior art under § 103(a).

The Applicant understands that the above-cited patent application of Farrington is a Continuation-in-Part of another patent application, now U.S. Patent No. 6,392,548. This patent application was filed on December 21, 2000, with a claimed priority date of December 23, 1999, from the English patent application no. GB 9930645. First, the parent application, that became U.S. Patent No. 6,392,548, was filed after the filing date of the corresponding Canadian patent application of the Applicant. Also, the parent application was published on June 28, 2001, which is also after the Canadian filing date of the Applicant's application. It must be borne in mind that, according to § 103(a), the prior art must have been publicly available before the invention was made in order to render an invention obvious. Since the latest possible date on which the Applicant's invention was made is August 18, 2000, and since the publication of the patent application that became U.S. Patent No. 6,392,548 occurred only on June 28, 2001, the publication of the patent application that became U.S. Patent No. 6,392,548 cannot be prior art under § 103(a).

As for the English patent application, after a verification on the Espacenet database, it clearly appears that this patent application was never published. The INPADOC legal status, enclosed

Application No. 09/931,896
Amendments Dated June 9, 2006
Reply to Office Action of March 10, 2006

herewith, is "Applications terminated before publication under section 16(1)". Thus, since the English patent application was also not published before the Canadian filing date of the application of the Applicant, this English patent application cannot be cited as prior art, under § 103(a), against the Applicant's application since it was not publicly available before the Canadian filing date and therefore before the invention was made.

It must also be noted that the Steinbach reference is still believed not to be prior art.

Therefore, even if it were possible that the teachings of Giniger, Steinbach and Farrington may be combined to obtain the claimed subject matter, and this is by no means an assumption that it is, this is irrelevant to the present case since the teachings of Steinbach and Farrington were not publicly available at the time the invention was made and thus do not constitute prior art with respect to § 103(a).

In view of the foregoing, it is therefore respectfully believed that claims 2, 4, 6 and 9 are fully patentable and that they should be allowed.

Claims 3 and 10

Claims 3 and 10 have been rejected under 35 USC §103(a) as being obvious in view of Giniger, Steinbach and Farrington and in further view of the U.S. Patent No. 5,926,116, granted to Hiroaki Kitano and Junichi Rakimoto (hereinafter "Kitano").

As explained above, the Applicant respectfully believes that the references of Steinbach and Farrington cannot be cited as prior art under § 103(a).

Therefore, even if it were possible that the teachings of Giniger, Steinbach, Farrington and Kitano may be combined to obtain the claimed subject matter, and this is by no means an assumption that it is, this is irrelevant to the present case since the teachings of Steinbach and Farrington were not publicly available at the time the invention was made and thus do not constitute prior art with respect to § 103(a).

Application No. 09/931,896
Amendments Dated June 9, 2006
Reply to Office Action of March 10, 2006

In view of the foregoing, it is therefore respectfully believed that claims 3 and 10 are fully patentable and that they should be allowed.

Claims 5 and 11

Claims 5 and 11 have been rejected under 35 USC §103(a) as being obvious in view of Giniger, Steinbach, Farrington and Kitano and in further view of the U.S. Patent No. 5,825,283, granted to Elie Cahmi (hereinafter "Cahmi").

As explained above, the Applicant respectfully believes that the references of Steinbach and Farrington cannot be cited as prior art under § 103(a).

Therefore, even if it were possible that the teachings of Giniger, Steinbach, Farrington, Kitano and Cahmi may be combined to obtain the claimed subject matter, and this is by no means an assumption that it is, this is irrelevant to the present case since the teachings of Steinbach and Farrington were not publicly available at the time the invention was made and thus do not constitute prior art with respect to § 103(a).

In view of the foregoing, it is therefore respectfully believed that claims 5 and 11 are fully patentable and that they should be allowed.

Claims 7 and 8

Claims 7 and 8 have been rejected under 35 USC §103(a) as being obvious in view of Giniger, Steinbach, Farrington and Cahmi.

As explained above, the Applicant respectfully believes that the references of Steinbach and Farrington cannot be cited as prior art under § 103(a).

Therefore, even if it were possible that the teachings of Giniger, Steinbach, Farrington and Cahmi may be combined to obtain the claimed subject matter, and this is by no means an

VEN/09/JUN/2006 10:59

Brouillette & Assoc.

N° FAX:514 395 8554

P.018/018

FOR EXAMINER'S INFORMATION

GB9990645D

Legal status (IPADOC) of GB9990645D

09 F

PRS Date :

PRS Code :

Code Expl :

EXAMINER 4

EXAMINER 4

AT

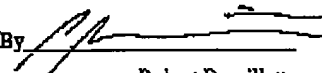
APPLICATIONS TERMINATED BEFORE PUBLICATION UNDER
SECTION 15(1)

(Patent of Invention)

Application No. 09/931,896
Amendments Dated June 9, 2006
Reply to Office Action of March 10, 2006

or practical, the Examiner is invited to telephone the undersigned, Applicant's agent of record, to facilitate the advancement of the present application.

Respectfully submitted,
BROUILLETTE & PARTNERS
Customer Number 56535

By 

Robert Brouillette
Reg. No. 31,930
1550, Metcalfe Street
Suite 800
Montréal, Québec, Canada H3A 1X6
Telephone: (514) 397-6900
Fax: (514) 395-8554
(6352-002-US-02)

Encl: INPADOC legal status of English Patent Application No. GB9930645;